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Filing Date	November 29, 2000
Appellant	Christopher A. Lee
Art Unit	3714
Examiner Name	Tramar Yong Harper
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☐ Fee Attached	☐ Licensing-related Papers	☐ Appeal Communication to Board of Appeals and Interferences
☐ Amendment/Reply	☐ Petition	
☐ After Final	☐ Petition to Convert to a Provisional Application	☒ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
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PATENTS
Attorney Docket No. ODS-20

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant	:	Christopher A. Lee
Application No.	:	09/727,248 Confirmation No. : 4353
Filed	:	November 29, 2000
For	:	INTERACTIVE WAGERING SYSTEM WITH AUTOMATIC RUNNER SELECTION
Art Unit	:	3714
Examiner	:	Tramar Yong Harper

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REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. § 41.41(a), appellant is filing this Reply Brief in reply to the Examiner's Answer dated October 26, 2007 (hereinafter "the Examiner's Answer"), and in support of their appeal from the rejection of claims 1-46 in the Office Action dated November 13, 2006. Appellant previously filed an Appeal Brief on September 13, 2007 (hereinafter "Appeal Brief") in connection with this appeal.

I. Introduction

Appellant maintains the position that claims 1-46 of the present application are patentable over Stronach PCT Publication No. WO 2000/67215 (hereinafter "Stronach") in view of Tulley et al. U.S. Patent No. 6,688,976 (hereinafter "Tulley").

Appellant submits that the Examiner's Answer is insufficient as a matter of law to uphold the 35 U.S.C. § 103(a) rejection for at least the reasons set forth in appellant's Appeal Brief. Appellant has filed this Reply Brief to address comments in the Examiner's Answer and to further demonstrate the patentability of pending claims 1-46.

II. Summary of the Examiner's Answer

The Examiner's Answer maintains the § 103(a) rejection of claims 1-46 from the November 13, 2006 Office Action and restates the same grounds of rejection from that Office Action.

The Examiner's Answer also provides a "Response to Arguments" section that attempts to clarify the § 103(a) rejection and rebut appellant's arguments made in appellant's Appeal Brief.

III. Summary of the Appellant's Reply

Appellant's Appeal Brief fully addresses the grounds of rejection stated in the November 13, 2006 Office Action.

This Reply Brief addresses the Examiner's comments on appellant's arguments contained in the Appeal Brief.

Appellant submits that the Board should find the rejections of claims 1-46 to be in error and should reverse the Examiner.

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IV.   The 35 U.S.C. § 103(a) Rejection

In the Appeal Brief, appellant provided at least three reasons why the § 103(a) rejection should be reversed. First, appellant argued that, contrary to the Examiner's contention, Tulley does not disclose or imply that his "Quick Pick" feature is to be used with parimutuel racetrack wagering. *See* Appeal Brief, pages 5-6. Second, appellant argued that there is no motivation for one skilled in the art to incorporate Tulley's "Quick Pick" feature into Stronach's wagering terminals because the combination would provide no real benefit or functionality that did not already exist in Stronach. *See* Appeal Brief, pages 7-8. Finally, appellant argued that the combination suggested by the Examiner would be counterintuitive and illogical to one skilled in the art. *See* Appeal Brief, pages 8-10.

The Examiner, in the Examiner's Answer, attempts to rebut each of appellant's three arguments. For the reasons set forth below, appellant submits that the Examiner's rebuttal arguments are unconvincing and insufficient to maintain the § 103(a) rejection of claims 1-46.

A.   Tulley Does Not Disclose or Imply that His "Quick Pick" Feature Is To Be Used in a Parimutuel Racetrack Wagering Context

In the Examiner's Answer, the Examiner attempts to provide additional support for why the Examiner believes that Tulley discloses that his "Quick Pick" feature may be used in a parimutuel racetrack context. In buttressing his argument, however, the Examiner has mischaracterized Tulley's invention.

Tulley states that his "present invention" may be used with parimutuel racetrack betting. *See* Tulley, col. 21, ll. 40-44. The Examiner contends that the phrase

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"present invention" encompasses the "entirety" of Tulley's invention including every aspect of every embodiment. *See* Examiner's Answer, page 6. Since Tulley describes a "Quick Pick" feature that may be used in one embodiment to automatically select lottery numbers, the Examiner maintains his contention that Tulley discloses that his "Quick Pick" feature may be used to automatically select runners for a parimutuel racetrack wager. *See* Examiner's Answer, pages 6. Even though Tulley does not expressly disclose the possibility of using the "Quick Pick" feature to automatically select runners for a parimutuel racetrack wager, the Examiner now contends that Tulley "provides enough disclosure that one of ordinary skill in the art would apply the 'Quick Pick' feature . . . towards parimutuel racetrack betting" (Examiner's Answer, page 7). Appellant respectfully disagrees with both of the Examiner's contentions.

First, Tulley's only stated example of applying his "present invention" to the parimutuel racetrack context refers to associating a parimutuel racetrack wager with a limited number of occurrences. *See* Tulley, col. 21, ll. 40-53. The Examiner does not contest this point. Moreover, as explained in appellant's Appeal Brief, Tulley's stated "present invention" is the ability to associate a wager with a limited number of occurrences. Nowhere does Tulley state or imply that his invention is a random "Quick Pick" process. As such, appellant submits that one skilled in the art would understand that Tulley's use of the phrase "present invention" is directed to the ability to associate a wager with a limited number of occurrences. Therefore, Tulley does not expressly disclose that that his "Quick Pick" feature may be used to automatically select runners for a parimutuel racetrack wager.

Furthermore, there is nothing in Tulley that would suggest a different result. The Examiner, in the Examiner's Answer, stresses the point that Tulley mentions that a

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player "may also" request that his or her wager be associated with a limited number of occurrences. The Examiner contends that this phrase "makes the limited occurrences feature an additional feature and not a limiting feature" (Examiner's Answer, pages 6-7). However, this statement in Tulley merely reiterates that a user may apply the limited number of occurrences feature to racetrack betting. The "may also" language refers to an extra step that may be requested by the user. For example, the sentence immediately preceding the "may also" sentence reads: "For example, some types of racetrack bets require that a user select, in order, the top three horses that will win a race" (Tulley, col. 21, ll. 44-46). The "may also" language immediately following this sentence therefore refers to an *additional request* that the user may make in order to limit his or her wager with a limited number of occurrences. This language does not suggest or imply that Tulley's stated "present invention" includes additional features beyond the limited number of occurrences feature.

In view of the foregoing, one skilled in the art would not conclude that Tulley's disclosure suggests or implies the use of Tulley's "Quick Pick" feature to automatically select runners for a parimutuel racetrack wager. As described above, one skilled in the art would only understand Tulley to suggest applying the limited number of occurrences feature (i.e., Tulley's stated invention) to parimutuel racetrack wagers, not the "Quick Pick" feature.

Without some additional suggestion from Tulley to use the "Quick Pick" feature for parimutuel racetrack wagers, the Examiner has not met his burden in establishing a *prima facie* case of obviousness. For at least this reason, appellant requests that the Board reverse the Examiner's rejection of claims 1-47.

B. Stronach Already Includes an Automatic Candidate Selection Process

The Examiner agrees that Stronach's wagering terminals already provide a means for automatically selecting racing candidates. *See* Examiner's Answer, page 7. As explained in appellant's Appeal Brief, each time the candidate reselection button is actuated, a different candidate reselection algorithm is employed to automatically select the racing candidates for use in the wager. None of the candidate reselection algorithms is based on a random process or uses a random number generation application. *See* Stronach, page 10, ll. 24-27. Rather, each algorithm uses "different weights to the various handicapping data" in order to select candidates. *Id.* As such, each algorithm can be said to be deterministic, not random.

According to the Examiner, since Stronach provides multiple candidate reselection algorithms and a different algorithm is used each time candidates are selected, Stronach discloses "a type of random automatic application means of selecting racing candidates" (Examiner's Answer, page 7-8). For example, the Examiner alleges that if there are ten available candidate reselection algorithms available, then some random means must be used to select one of the ten available algorithms. *Id.*

The Examiner's arguments are not convincing. Just because there are multiple candidate reselection algorithms and one of these algorithms must be selected does not mean that Stronach utilizes a random process to select an algorithm. For example, Stronach's wagering terminals could select the first algorithm first, the second algorithm second, the third algorithm third, and so on. There is no need to randomly select one of the algorithms, and there is no suggestion in Stronach that any random process is used to select an algorithm.

Moreover, a random selection process would be contrary to Stronach's own disclosure. Stronach teaches

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that each time the candidate reselection button is actuated a different candidate selection algorithm is used. *See* Stronach, page 10, ll. 24-27. By definition, a random process for selecting one algorithm from a number of possible algorithms would select the same algorithm approximately 10% of the time. A random selection routine, therefore, would not meet Stronach's own description of its automatic candidate selection process.

Just because different algorithms may be selected according to some deterministic formula does not make the selection random, nor does it necessarily imply the use of a random number generation application, as recited in appellant's independent claims. The Examiner cannot escape the fact that Stronach already includes an automatic candidate selection process that is perfectly suitable for Stronach's purposes. As such, appellant submits that there is no motivation for one skilled in the art to incorporate yet another process for automatically selecting racing candidates using a random number generation application. For at least this reason, appellant requests that the Board reverse the Examiner's rejection of claims 1-47.

C.   The Combination of Stronach and Tulley
     Would be Counterintuitive and Nonobvious

Appellant also argued in the Appeal Brief that the combination of Stronach and Tulley would be counterintuitive and nonobvious for additional reasons. *See* Appeal Brief, pages 8-10. The thrust of appellant's arguments was that selecting lottery numbers is different than selecting racing candidates. In parimutuel wagering, numerous factors affect the performance of the runners in a race and therefore the odds for the runners are typically all different. Wagerers often rely on racing information such as handicapping information to make an informed runner selection. Lottery games, on the other hand, are random events. Each number

has equal odds of being selected. Accordingly, one skilled in the art would not find it obvious to apply a random selection process from a game that has equal odds to a race where each runner typically has different odds. It would be counterintuitive.

The Examiner, in the Examiner's Answer, attempts to compare the selection processes used in Tulley and Stronach. *See* Examiner's Answer, page 10-11. The Examiner seems to contend that Tulley's "Quick Pick" feature uses weighted variables, like Stronach's candidate selection algorithms, because it must select numbers that satisfy the limited number of occurrences criteria. *See* Examiner's Answer, page 11. However, this is not the case because FIG. 7B of Tulley shows that Tulley's system selects lottery numbers without regard to any limited number of occurrences request. *See* Tulley, col. 17, ll. 35-63. If the limited number of occurrences criteria is not satisfied, Tulley's system randomly chooses a new set of lottery numbers. This process is repeated until a valid set of lottery numbers is chosen. *Id.* The Examiner's attempt to analogize Tulley's "Quick Pick" feature to Stronach's weighted variables is therefore incorrect.

In view of the foregoing, appellant submits that independent claims 1 and 24 are allowable over Stronach and Tulley. There is no reason why one skilled in the art would incorporate Tulley's random quick pick process into Stronach's wagering terminals. Appellant further submits that dependent claims 2-23 and 25-46, which contain all the limitations of independent claims 1 and 24, respectively, are allowable for at least the same reasons. Appellant respectfully requests, therefore, that the rejection under 35 U.S.C. § 103(a) be reversed.

V.   Conclusion

For at least the foregoing reasons, as well as the reasons set forth in appellant's Appeal Brief, appellant submits that the Board should find the § 103(a) rejection of claims 1-46 to be in error and should reverse the Examiner.

Respectfully submitted,
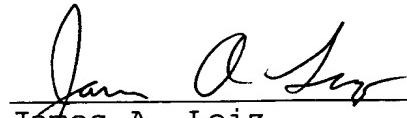
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